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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/593,386

12/04/2006

John Fleming Walker

7251/96026

8885

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7590

11/26/2008

Husch Blackwell Sanders, LLP

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EXAMINER

LAM, CATHY N

ART UNIT

PAPER NUMBER

2811

MAIL DATE

DELIVERY MODE

11/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/593,386	Applicant(s) WALKER, JOHN FLEMING	
	Examiner CATHY N. LAM	Art Unit 2811	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-32 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

RESTRICTION / REQUIREMENT FOR ELECTION

Restriction is required under 35 U.S.C. §§ 121 and 372.

1. This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

a. Group I, claim(s) 23-24 drawn to an integrated circuit, class 257, subclass 758.

b. Group II claim(s) 1-22, 25-32 drawn to a method for making an integrated circuit, class 438, subclass 190.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Restriction under unity of invention in national stage applications submitted under 35 U.S.C. § 371 is proper when two criteria are met: (1) the different groups of claims are listed; and (2) lack of unity identifying the unique special technical features of each group is explained. See MPEP § 1893.03(d).

The inventions listed above as Groups I and Group II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features because each group includes different special technical features that define a different contribution which each of the groups, considered as a whole, makes over the prior art. See MPEP § 1850. For example, the device of Group I does not require an additional layer of material whose conductivity can be altered; a first portion of the additional layer by selective annealing; a second integrated circuit; the shape of the first portion of the first integrated circuit is

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different from the shape of the first portion of the second integrated circuit as require in Group II.

The election of an invention may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

2. This application also contains claims directed to more than one species of the generic invention. The species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species and corresponding unique special technical features are as follows:

- I. e.g., Fig. 1, drawn to an integrated circuit having a protective layer.
- II. e.g., Fig. 7A, drawn to an integrated circuit with preferred patterns of the conductive portion as shown in fig.7A, for detecting break in the conductive portion.
- III. e.g., Fig 7B, drawn to an integrated circuit with preferred patterns of the conductive portion as shown in fig.7B, for detecting "short" in the conductive portion.

Currently, no claim is generic.

Restriction is being made under 35 U.S.C. §§ 121 and 372.

In accordance with 37 CFR § 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Restriction under unity of invention in national stage applications submitted under 35 U.S.C. § 371 is proper when two criteria are met: (1) different species of the

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invention are listed; and (2) lack of unity identifying the unique special technical features of each species is explained. See MPEP § 1893.03(d).

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features because each species includes different special technical features that define a different contribution which each of the inventions, considered as a whole, makes over the prior art. See MPEP § 1850.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of the species to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected species.

The election of a species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew O. Arena whose telephone number is 571-272-5976. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne A. Gurley can be reached on 571- 272-1670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. For more info about PAIR, see <http://pair-direct.uspto.gov>. For questions PAIR access, contact the Electronic Business Center at 866-217-9197 (toll-free). For assistance from a USPTO Customer Service Rep or access to the automated info system, call 800-786-9199 or 571-272-1000.

/Lynne A. Gurley/
Supervisory Patent Examiner, Art Unit 2811

CL
11/08/2008